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OFFICE OF PETITIONS

In re Application of	:	
TILLEY, et. al.	:	
Application No. 10/726,801	:	DECISION ON PETITION
Filed: December 2, 2003	:	
Attorney Docket No. 309-002	:	

This is in response to the **renewed** petition under 37 CFR 1.47(a), originally filed April 5, 2004 and resubmitted on May 5, 2006 (with evidence of facsimile transmission on April 5, 2004).

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor.

Applicant lacks item (1) above.

The petition states that a declaration for the present application and a cover letter with instructions were sent to the non-signing inventor Douglas Linc Clark via certified mail on November 12, 2003. The certified letter was not claimed and subsequently returned to the sender unopened.

While the declaration of Sandra L. Etherton states that a copy of the certified mail papers, postal receipt, and shipment rejection from the U.S. Postal Service were enclosed with the petition, copies of such were not found in the file record.

As to item (1), the applicable statute (35 U.S.C. § 116) requires that a “diligent effort” have been expended in attempting to find or reach the non-signing inventor. *See* MPEP 409.03(a). The showing currently fails to demonstrate, with a documented showing, that a diligent effort was made to find or locate non-signing inventor Douglas Linc Clark, such that the declaration can be accepted under 37 CFR 1.47(a). Where inability to find or locate a named inventor(s) is alleged, a statement of facts should be submitted that fully describes the exact facts which are relied on to establish that a *diligent effort* was made to locate the inventor.

The evidence of record only shows one attempt was made to present Mr. Clark with the declaration papers via the certified mail communication dated November 12, 2003. This single instance cannot be construed as evidence of a “diligent effort” to contact Mr. Clark since one unclaimed letter is not a *bona fide* indication of a refusal to sign the application papers. Furthermore, the declaration of co-inventor Michael J. Tilley’s statement that on or about October 30, 2003 Mr. Clark said “he would not sign any papers and would not pay until he talked to a lawyer” cannot be construed to be an expressed refusal since it was a conditional statement and only six business days elapsed between the date of the conversation and the mailing of the certified mail communication on November 12, 2003 which was never received by Mr. Clark.

Furthermore, the evidence of record fails to show that the non-signing inventor was presented with the complete application papers including the specification, drawings, and claims along with the declaration. The certified mail communication sent to Mr. Clark only contained a declaration and coversheet with instructions. Since the certified mail communication was never received, there is no evidence of record to show that Mr. Clark has in his possession a copy of the declaration and application papers for which he failed to sign or any knowledge that such papers were sent to him to constitute a refusal after November 12, 2003 since there appears to be no further communications between the petitioner and Mr. Clark.

At the very least, petitioner should mail correspondence to the inventor’s last known address, return receipt and/or forwarding address requested. If a forwarding address is provided, petitioner should then mail a complete copy of the application papers (specification, claims, drawings, oath, etc.) to Mr. Clark’s address, return receipt requested, along with a cover letter of instructions which includes a deadline or a statement that no response will constitute a refusal. This sort of ultimatum lends support to a finding of refusal by conduct. If the papers are returned and all other attempts to locate or reach the inventor, e.g., through personnel records, co-workers, E-mail, the Internet or the telephone, etc., continue to fail, then applicant will have established that the inventor cannot be reached after diligent effort or has refused to join in the application. **The statements of facts must be signed, where at all possible, by a person having firsthand knowledge of the facts recited therein and should be accompanied by documentary evidence in support of the statement of facts.** It is important that the forthcoming communication contain statements of fact as opposed to conclusions.

When it is concluded by the rule 47 applicant that an omitted inventor’s conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in an affidavit or declaration. If there is documentary evidence to support facts alleged in the affidavit or declaration, such evidence must be submitted.

Whenever an omitted inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the affidavit or declaration.

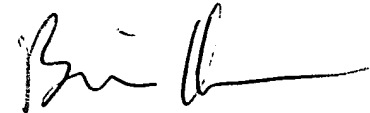
Further correspondence with respect to this matter should be addressed as follows:

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By hand: Customer Service Window
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 Randolph Building
 401 Dulany Street
 Alexandria, VA 22314

By fax: (571) 273-8300
 ATTN: Office of Petitions

Telephone inquiries should be directed to Amelia Au at (571) 272-7414.

A handwritten signature in black ink, appearing to read 'Brian Hearn', with a long horizontal stroke extending to the right.

Brian Hearn
Petitions Examiner
Office of Petitions